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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/551,577	10/03/2005	Hisato Uto	Q90071	3885
23373 7590 02/03/2009 SUGHRUE MION, PLLC 2100 PENNSYLVANIA AVENUE, N.W. SUITE 800 WASHINGTON, DC 20037				
EXAMINER STEELE, JENNIFER A				
ART UNIT		PAPER NUMBER		
1794				
MAIL DATE		DELIVERY MODE		
02/03/2009		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/551,577

Applicant(s)

UTO ET AL.

Examiner

JENNIFER STEELE

Art Unit

1794

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 February 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,4,5 and 7-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,4,5 and 7-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SI-08)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date _____

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1. Claims 1, 2, 4, 5, 7-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shimizu et al USPN 6183842 in view of JP 62-198455 A (as cited in the search report) further in view of USPN 7101644 issued to Toshine et al.

USPN 6183842 issued to Shimizu et al discloses making a decorative laminate comprising a substrate layer composed of a polyester type resin layer and a transfer foil laminated to it (abstract, column 4, line 31-column 5 line 5). The resin layer is may be embossed to created concavities to which the foil may be transferred upon (column4, line 63). Shimizu et al does not suggest scaring the resin layer. Shimizu differs and does not teach a pigment containing layer.

As cited in the search report, which at this point the Examiner must believe, is true, since the Examiner cannot obtain the cited reference, nor has Applicant provided the same. However, the cited search report states that in Document 4 (JP 62-198455 under the heading "Effects of the Invention" that scraping is a well known technique and utilized by those skilled in the art. Thus, a skilled artisan would have found it obvious to manipulate the surface of Shimizu et al, instead of embossing. One would have been

motivated to scrape by hand instead of utilizing a machine embossing treatment motivated by the desire to reduce economical costs in manufacturing said composite.

It should be noted the Merriam Webster's Dictionary defines scrape as

1 a : to remove from a surface by usually repeated strokes of an edged instrument b : to make (a surface) smooth or clean with strokes of an edged instrument or an abrasive
2 a : to grate harshly over or against b : to damage or injure the surface of by contact with a rough surface c : to draw roughly or noisily over a surface. Both of these definitions read on embossing of a surface.

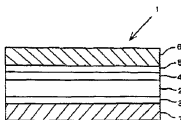
The above combination also fails to suggest the use of a release base layer. USPN 7101644 issued to Toshine et al. remedies this and teaches the use of removable release layers (column 20) in foil/resin laminates. Toshine teaches a pigment containing layer adjacent the embossed or scarred layer. A person having ordinary skill in the art at the time the invention was made would have found it obvious to use a release layer in the composite of Shimizu and JP 62-198455. One would have been motivated to do so in order to prevent the migration of chemicals from one layer to the other, or alternatively assist in the transportation of rolls of such materials so that the layers don't stick to one another.

As to new claim 9-12, Shimizu differs and does not teach a pigment containing layer. Toshine teaches a pigment containing layer and teaches the pigment containing layer, called a heat seal layer 3, and teaches the amount of pigment incorporated into the heat seal layer should be 1% to 40% by weight (col. 11, lines 16-67). The heat seal layer of Toshine is equated with the release coat layer of the current application as

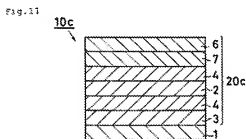
Art Unit: 1794

shown in a comparison of the layers of Toshine of Fig. 1 and the current Application's Fig. 11. Fig. 1 of Toshine has layers 2 a hologram layer, 3 a heat seal layer, 4 a thermoplastic resin, 5 a surface protective layer, 6 a substrate and 7 a releasable sheet.

FIG. 1



The current Application's Fig. 11 shows layers, 6 a release base layer film, 7 a resin release coat layer that contains the pigment, 4 a resin layer, 2 resin coat layer, 4 a resin layer, 3 and adhesive and 1 a base sheet.



Current Application		Toshine	
1 Base Sheet	Resin	6 Substrate	Resin film
3 Adhesive	Resin based adhesive – PVC resin	7 Surface Protective Layer	Must have adhesion to resin layer 4 – PVC resin
4 Resin		4 Resin Layer	
2 Resin Coat Layer	Scraped Layer	2 Hologram Layer	Relief layer that is stamped to form

			pattern on surface
4 Resin Layer			
7 Release Coat Layer - Pigment	1-50% pigment	3 Pigmented Layer	1-40% pigment
6 Release base layer film	PET, PVC film, release paper which has a release agent	7 Releasable Sheet	Release paper or PET or PP film treated with silicone or fluorine release agent

It would have been obvious to employ a pigmented layer adjacent to the relief embossed or scraped resin layer motivated to produce an enhanced contrast and visual effect as taught by Toshine. It further would have been obvious to scrape the layer as taught by JP 62-198455 A versus embossing or press stamping as both techniques produce an uneven surface that will create a desired surface and visual effect.

Response to Arguments

1. Applicant's arguments filed 2/21/2008 have been fully considered but they are not persuasive. Applicant's amended claim 1 to describe a pigment containing release coat layer and added new claims 9-12 to describe the amount of pigment in the release coat layer is 1-50%. The previous Office Action is maintained and new grounds presents for new claims 9-12.
2. Applicants argue that the pigment containing release coat layer is opaque and if a pigment containing release coat layer is applied to a hologram sheet, the hologram would not be visible. However Toshine teaches that the heat seal layer adjacent to the hologram layer can be colorless but also teaches when the hologram layer is a volume or transparent relief hologram layer it is preferable to incorporate a coloring agent in the

heat seal layer because pigmented heat seal layer can provide a hologram image of enhanced contrast (col. 11, lines 29-35). Therefore the pigmented heat seal layer does not render the hologram useless and Applicants arguments are not persuasive.

3. Applicant argues that before scraping, a decorative sheet is colored by pigment and when the sheet is scraped, the surface of the sheet is decolorized, because the pigment containing release coat layer is scraped away. Applicant is not claiming that the release coat layer is scraped, Applicant is claiming that the resin coat layer is scraped. Applicant's arguments are not commensurate with the scope of the claims.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JENNIFER STEELE whose telephone number is (571)272-7115. The examiner can normally be reached on Office Hours Mon-Fri 8AM-5PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Donald Tarazano can be reached on (571) 272-1515. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/J. S./
Examiner, Art Unit 1794

/Elizabeth M. Cole/
Primary Examiner, Art Unit 1794

1/27/2009